

Remarks

Claims 1, 3, 4, 6, 7, 9 and 10 are amended.

Claims 1, 3-10 and 19-26 are pending and are under consideration.

The present claims are amended to require that substituent E_1 be limited to phenylalkyl or phenyl or substituted phenylalkyl or phenyl. G_2 then may also be hydrogen (as was stated for this case in original claim 1).

The claims are also amended to delete the definition of E_2 or E_2' being phenylalkyl or substituted phenylalkyl.

The proviso at the end of claim 1 deleted as now being redundant.

The remaining claims are amended to be consistent with claim 1.

Claim 4 is also amended to delete the definitions for "m" and "p". The definitions for "m" and "p" are defined in claim 1.

The specification is amended to update the reference to the parentage.

No new matter is added.

Claims 1, 3, 6, 9, 10 and 19-26 are rejected on the grounds of obviousness-type double patenting over claims 1-17 of U.S. Pat. No. 6,797,751.

A terminal disclaimer over this parent patent is attached herewith, thus obviating these rejections.

Claims 3 and 4 are rejected under 35 USC 112, second paragraph, for reasons of record.

Regarding the rejection of claim 3, G₂ may be hydrogen in claim 1. This is the case in original claim 1.

Claim 4 is repaired by amendment as outlined above.

In view of this, Applicants submit that the 35 USC 112, second paragraph rejections are addressed and are overcome.

Prior art rejections are as follows:

1) Claims 1, 3, 4, 7, 19-23, 25 and 26 are rejected under 35 USC 102(b) as anticipated by or, in the alternative, under 35 USC 103(a) as obvious over **Winter**, et al., U.S. Pat. No. 5,280,124.

2) Claims 1, 3, 19-23, 25 and 26 are rejected under 35 USC 102(b) as anticipated by or, in the alternative, under 35 USC 103(a) as obvious over **Birbaum**, et al., U.S. Pat. No. 5,597,854.

3) Claims 1, 3, 4, 7, 19-23, 25 and 26 are rejected under 35 USC 103(a) as being obvious over **Winter** in view of **Birbaum**.

4) Claims 1, 3, 21-23, 25 and 26 are rejected under 35 USC 102(b) as being anticipated by or, in the alternative, under 35 USC 103(a) as obvious over **Rody**, et al., U.S. Pat. No. 4,127,586 or **Dexter**, et al., U.S. Pat. No. 4,315,848.

5) Claims 1, 3, 19, 21-23, 25 and 26 are rejected under 35 USC 102(b) as anticipated by or, in the alternative, under 35 USC 103(a) as obvious over **Avar**, et al., U.S. Pat. No. 4,891,396.

6) Claims 1, 3-5, 7, 19-23, 25 and 26 are rejected under 35 USC 103(a) as being obvious over **Avar** in view of **Winter** or further in view of **Birbaum**.

7) Claims 1, 3-5, 7, 19-23, 25 and 26 are rejected under 35 USC 103(a) as being obvious over **Birbaum** in view of **Winter**.

Avar does not disclose compounds where present E₁ is phenyl or phenylalkyl. Present E₁ must be phenyl or phenylalkyl. **Avar** thus does not disclose the present benzotriazoles.

Dexter requires present E₁ and E₂ to be a phenylalkyl group. Present E₂ is not phenylalkyl. **Dexter** does not disclose the present benzotriazoles.

Birbaum does not disclose the present benzotriazoles.

Rody and **Winter** do teach some of the present benzotriazole compounds, but do not specifically teach the protection of contents in plastic containers. In fact **Rody** and **Winter** mention shaped articles but do not specifically mention containers.

In view of the present amendments and these remarks, Applicants submit that the 35 USC 102(b) rejections are addressed and are overcome.

Regarding the 35 USC 103(a) rejections, only **Rody** and **Winter** teach some of the present benzotriazole compounds.

Applicants submit that as the other references only very generically mention containers, and do not teach content protection in clear or lightly colored containers, that the present claims cannot be obvious over **Rody** or **Winter** in combination with any of the other references. There is no motivation provided from any combination of cited references to protect the contents of clear or lightly colored containers with the present benzotriazoles.

Further, each of **Rody** and **Winter** equate compounds where present E₁ is phenylalkyl or alkyl. Present benzotriazoles where E₁ is phenylalkyl provide outstanding results compared to one where E₁ is alkyl. In the working Examples, two benzotriazoles where E₁ is phenylalkyl are compared to one where E₁ is alkyl; 3- α -cumyl-2-hydroxy-5-t-octylphenyl-2H-benzotriazole and 5-trifluoromethyl-2-(2-hydroxy-3- α -cumyl-5-t-octylphenyl)-2H-benzotriazole are compared to 5-chloro-2-(2-hydroxy-3,5-di-tert-butylphenyl)-2H-benzotriazole.

That is, formulations 4 and 5 are compared to formulation 2. Please see pages 56 and 57 of the specification. Please further see Examples 3 through 15 on pages 59-67 of the specification. Formulations 4 and 5 are consistently superior to formulation 2 in protecting the contents of bottles. The contents are mouthwashes, dye solutions and shampoos. These outstanding results for the presently claimed benzotriazoles could not have been predicted from the combined disclosures of the cited art.

Thus, Applicants submit that the 35 USC 103(a) rejections are addressed and are overcome.

In light of the present terminal disclaimer, the present amendments, above remarks and the present working Examples, Applicants submit that each of the obviousness type double patenting, 35 USC 112, second paragraph, 35 USC 102(b) and 35 USC 103(a) rejections are overcome.

The Examiner is kindly requested to reconsider and to withdraw the present rejections.

Applicants submit that the present claims are in condition for allowance and respectfully request that they be found allowable.

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Respectfully submitted,



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Attachments: Terminal Disclaimer over U.S. Pat. No. 6,797,751
Fee Letter